

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <div style="text-align: center;">1163-0482P</div>	
	Application Number 10/699,870-Conf. #5118	Filed November 4, 2003	
	First Named Inventor Tomoyuki ASAHARA		
	Art Unit <div style="text-align: center;">3661</div>	Examiner <div style="text-align: center;">C. H. Nguyen</div>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,680</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 45%; text-align: center;"> <p><i>Penny Caudle</i> Penny Caudle _____ Signature Reg. # 46,607</p> <p><i>for</i> Michael K. Mutter _____ Typed or printed name</p> <p><u>(703) 205-8000</u> Telephone number</p> <p><u>October 10, 2006</u> Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

**APPLICANT'S REASONS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

At the outset, Applicant respectfully notes that the finality of the Office Action ("Action") mailed on June 7, 2006 was improper. In the Action, the Examiner asserts that "[b]ecause the applicant amends independent claims 1, and 8; different grounds of rejections are applied." [SIC] However, Applicant notes that the amendments to claim 1 were clerical in nature and did not change the scope of the claimed subject matter. More specifically, claim 1 was amended to correct typographical and/or translation errors in order to more closely conform with U.S. patent practice.

In the previous Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Patent No. 6, 148,090 to Narioka ("Narioka"). However, in the present Action, the Examiner now rejects claim 1 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Narioka in view of Microsoft Word. More specifically, the Examiner now asserts that although Narioka fails to disclose extracting character data from displayed images, it would have been obvious to modify Narioka to include the "Find and Replace" functionality of Microsoft Word.

Original claim 1 recited "character data extracting means for extracting character string data of specific information on the specific point from among images displayed on the display control means." Likewise, amended claim 1

recites “a character data extracting unit that extracts a character string including specific information regarding the specific point from among images displayed on the display.” It is clear that Applicant’s amendment to remove the “means” language did not necessitate the Examiner’s new grounds of rejection. Accordingly, the finality of the Action was improper.

Furthermore, the Examiner’S rejection of claims 1-5 and 7-11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,148,090 to Narioka (“Narioka”), in view of Microsoft Word (“Word”) because the Examiner fails to establish a *prima facie* case of obviousness, as discussed below.

First, Applicant notes that the rejection is improper inasmuch as the Examiner failed to provide any evidence that “Microsoft Word” is prior art under 35 U.S.C. § 103(a). Nowhere in the Action does the Examiner assert which version of Word he is relying on nor does he provide any evidence that the functionality relied on was available prior to the filing date of the present application.

Second, even if the Examiner were to establish that the version of Word relied upon was prior art, the combination would still fail to render claimS 1-5 and 7-11 unpatentable because the combination fails to disclose each and every claimed element.

In rejecting claim 1, the Examiner asserts that Microsoft Word has performed “that well-known extracting function while editing a document.” To support this assertion, the Examiner appears to point to the “Find and Replace”

functionality provided by Word. Therefore, the Examiner concludes that it would have been obvious to one skilled in the art to modify Narioka's system "by adding above Microsoft Word function on finding a character string on displayed images for the convenience of a driver to copy exactly a character string having in a database with no typo error." This assertion is unfounded for the following reasons.

Even if one skilled in the art were motivated to modify Narioka to include the ability to cut and paste or find and replace a selected character string as suggested by the Examiner, which Applicant does not concede, the modification would still fail to render claim 1 unpatentable. Nowhere in Narioka is there any disclosure or suggestion of a route searching unit that searches routes based on conditions set in position information and specific information extracted by the character data extracting unit. Therefore, even if one skilled in the art were motivated to modify Narioka to include the ability to extract a character string, nowhere in Narioka is there any disclosure or suggestion of using the information contained in the extracted character string to search routes as claimed. Accordingly, independent claim 1 is patentable over the combination of Narioka and Word because the combination fails to disclose each and every claimed element.

Independent claim 8 defines a method of providing navigation assistance. The method includes, *inter alia*, receiving information on a specific point; displaying data regarding the specific point on a display; extracting a character

string including detailed information regarding the specific point from the displayed data; searching routes based on position data associated with the specific point and the detailed information contained in the extracted character string; and displaying a route which meets conditions set in the position information and the detailed information. Therefore, claim 8 is patentable over the combination of Narioka and Word for at least those reasons presented above with respect to claim 1, i.e., the combination fails to disclose or suggest extracting a character string and searching for routes based on the position data and detailed information contained in the character string as claimed.

Claims 2-5, 7, and 9-11 variously depend from independent claims 1 and 8. Therefore, claims 2-5, 7, and 9-11 are patentable over the combination of Narioka and Word for at least those reasons presented above with respect to claims 1 and 8.

In paragraph 6 of the Action, the Examiner rejects claims 6 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Narioka in view of U.S. Patent Application Publication No. US 2004/0036622 A1 to Dukach et al. ("Dukach"). Applicant respectfully traverses this rejection.

Claims 6 and 11 variously depend from independent claims 1 and 8 respectively. Therefore, claims 6 and 11 are patentable over Narioka for at least those reasons presented above with respect to claim 1. Dukach discloses a system for displaying messages on electronic displays, for example, mounted on vehicles. The system includes a GPS receiver so that a display's current

geographical location can be sensed, and then used to select which messages are shown on the display. However, Dukach fails to overcome the deficiencies of Narioka.

Since Narioka and Dukach both fail to disclose or suggest a navigation system that includes a character data extracting unit and routing searching unit as claimed, the combination of these two references cannot possibly disclose or suggest said feature. Therefore, even if one skilled in the art were motivated to combine Narioka and Dukach, which Applicant does not concede, the combination would still fail to render claims 6 and 11 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6 and 11 under 35 U.S.C. § 103.

For at least those reasons presented above, the Examiner's rejections should be withdrawn and the application allowed.